



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726.806	12/03/2003	Benjamin F. James IV	IND-38DIV	4108
27777	7590	08/25/2006	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			BLEVINS, JERRY M	
			ART UNIT	PAPER NUMBER
			2883	

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/726,806	Applicant(s) JAMES ET AL.	
	Examiner Jerry Martin Blevins	Art Unit 2883	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-24 and 26-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24 and 26-29 is/are allowed.
- 6) ☒ Claim(s) 15, 16, 22, 23 and 30 is/are rejected.
- 7) ☒ Claim(s) 17-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Terminal Disclaimer

The terminal disclaimer filed on May 30, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,522,806 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

Applicant's arguments filed January 24, 2006, with respect to claims 15, 16, 22, 23, and 30 have been fully considered but they are not persuasive.

Namely, Examiner maintains that the cited Dalton reference teaches that the sleeve extends at least from the proximal end to the distal face of the fiber core (column 13, line 7 – column 14, line 18).

Applicant's arguments, see pages 7 and 8, filed January 24, 2006, with respect to claims 17-21, 24, and 26-29 have been fully considered and are persuasive. The rejection of claims 17-21, 24, and 26-29 has been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2883

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15, 16, 23, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Dalton, US 6,138,406.

Regarding claims 15, 16, and 30, Dalton discloses a method of forming a medical device comprising the steps of: providing an optical fiber core having a proximal end and a distal face; associating the proximal end of the core with an optical connector; enclosing the fiber core in a continuous light transmitting sleeve by extending the sleeve distally of the distal face of the optical fiber core, wherein the sleeve has a length at least substantially the length of the optical fiber core extending from the optical connector to at least the distal face of the optical fiber core (Figure 1, column 8, lines 28-38 and column 9, lines 61-67).

Regarding claim 23, Dalton also teaches that the step of enclosing the optical fiber core in the sleeve results in the sleeve touching the core (Figures 4 and 5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dalton.

Regarding claim 22, Dalton as discussed above discloses the method of making a device. Dalton, however, does not disclose that the method includes the step of abrading a portion of the inner surface of the sleeve. As disclosed in page 2 of the specification of the present application, it is known to abrade the sleeve in order to conduct light from an optical coupling layer to the exterior. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Dalton to include the step of abrading a portion of the inner surface of the sleeve. The motivation would have been to improve conduction of light from the optical coupling layer to the exterior.

Allowable Subject Matter

Claims 17-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 24 and 26-29 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 17 and 19, Dalton teaches the limitations of the base claim 15. Dalton also teaches forming a tip in the sleeve, the tip being disposed distal of the distal face of the optical fiber core (column 13, line 7 – column 14, line 18), wherein a space is provided intermediate the distal face of the optical fiber core and the sleeve tip (Figures 3a, 3b). However, Dalton, either alone or in combination with the prior art, fails to disclose or render obvious that the tip is closed.

Regarding claim 18, Dalton teaches the limitations of the base claim 15. However, Dalton, either alone or in combination with the prior art, fails to disclose or render obvious an optical coupling layer intermediate a portion of the sleeve and a distal portion of the optical fiber core.

Claims 20 and 21 contain allowable subject matter due to dependence from claim 19.

Regarding claim 24, US Patent to Thielen, 6,315,775, discloses a method of making a device comprising the steps of: exposing a distal portion of an optical fiber; providing an optical coupling layer intermediate the distal portion of the optical fiber core and the sleeve; and forming a closed, tissue penetrating tip disposed distal of the distal portion of the fiber core (abstract, column 2, lines 43-45 and 64-66, column 3, lines 25-27, and Figure 1). However, Thielen, alone or in combination with the prior art, fails to disclose or render obvious that the penetrating tip is located in the sleeve.

Claims 26-29 are allowed based on dependence from claim 24.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

Art Unit: 2883

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Martin Blevins whose telephone number is 571-272-8581. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font can be reached on 571-272-2415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMB


Frank G. Font
Supervisory Patent Examiner
Technology Center 2800